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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,898	06/27/2003	William A. Groll	916-030481	7789

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,898	Applicant(s) GROLL, WILLIAM A.	
	Examiner John J. Zimmerman	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 5 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 7 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

SECOND OFFICE ACTION

Amendments

1. The Amendment received June 14, 2004 has been considered. Claims 1 and 3-18 are pending in this application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 6-7 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stein (U.S. Patent 3,340,597).
4. Stein (e.g. see Example 4) discloses a multilayered composite sheet made from a plurality of roll bonded layers including an inner layer of a lower coefficient of thermal conductivity material (304 type stainless steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). A heating temperature step includes ranges between 500-975°F (e.g. see column 3, lines 34-46) and includes cleaning steps to remove oxide surfaces (e.g. column 2, lines 50-57). The composite sheet is useful for making cooking utensils (e.g. see column 2, lines

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33-44). The examiner notes that the definition of "cookware" is "utensils used in cooking" (Webster's New Collegiate Dictionary, copyright 1977). Stein shows an example aluminum/stainless/aluminum composite (e.g. see Example 4; column 5, lines 5-22). Specific alloys for Stein's invention, such as 304 stainless steel, pure aluminum and aluminum alloys, are disclosed (e.g. see column 2, lines 5-32). Regarding the forming step of the claims, Stein's disclosure of that the composite sheet is to be made into cookware provides sufficient specificity for the step of forming the composite sheet into cookware. The showing of a drawing step to form pans in Example 2 and Example 3 is sufficient to show the use of this step to be disclosed with sufficient specificity for Stein's composites. Regarding the distribution of heat in a lateral direction, the ability to laterally distribute heat would be inherent to the materials and construction of the composite sheet. Since the materials and construction are the same as those claimed by applicant the distribution of heat would be expected to be the same. Discovery of a new property or use of previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to known composition, *In re Spada*, 15 USPQ2d 1655 (Court of Appeals, Federal Circuit 1990). Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Regarding the applicant's generic

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recitation of "cookware" in the rejected claims, the examiner notes that no particular physical structure is imparted on the claims by this recitation since "cookware" can be any shape. The term "cookware" does not physically distinguish these claims from the applied art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (U.S. Patent 3,340,597) in view of applicant's disclosure of the prior art.

7. Stein is discussed above. Stein may differ from claims 12 and 16-17 in that Stein may not disclose a step of applying a non-stick layer to the cook surface of his cookware. Applicant, however, admits that it is well known in the art to provide cook surfaces with non-stick layers (e.g. see paragraph [0004] of the specification) and the examiner notes that aluminum cookware is conventionally anodized to protect the surface. It is generally understood in the cooking art that non-stick coatings allow a cook to use less oil and also allows for easier cleanup and that anodizing allows for better scratch resistance. It must be assumed that one of ordinary skill in a particular art understands the basic concepts in that art. In view of applicant's disclosure of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention

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was made to apply a non-stick surface or an anodized surface to the cookware of Stein because it is generally understood that non-stick surfaces on cookware allow for cooking with less oil and also provide for easier cleanup of the cookware and anodized cookware is more scratch resistant.

Allowable Subject Matter

8. Claims 3 and 5 are allowed. Claims 8-11 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not anticipate or make obvious the specific combination of materials and/or process steps in the manners required by these claims.

Response to Arguments

9. Applicant's arguments filed June 14, 2004 have been fully considered but they are not persuasive with regards to the remaining rejections.

10. Regarding the rejections applying Stein (U.S. Patent 3,340,597), applicant argues that Stein's embodiments having a stainless steel core are not directed to cookware, but rather to automotive trim. The examiner does not find applicant's arguments persuasive since Stein specifically discloses that the composite sheets of his invention are indeed useful for making "cooking utensils" (e.g. see column 2, lines 33-44). The examiner notes that the definition of "cookware" (the wording used in applicant's claims) is "utensils used in cooking" (Webster's New Collegiate Dictionary, copyright 1977). The examiner notes that Example 4 of Stein does

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not disclose the step of being drawn to form a pan, but there is no indication in Example 4 of Stein that this specific embodiment is not to be used for cooking utensils. In view of the fact that Stein does specifically disclose that cooking utensils are an ultimate use of his disclosed composites (e.g. column 2, lines 33-44) and the fact that Stein does clearly disclose drawing his composites to form pans, it would have been understood by one of ordinary skill in the art at the time the invention was made that any of Stein's disclosed composite embodiments are sufficiently disclosed for this use. It is not necessary that Stein draw every single one of his example composite embodiments into pan form. The general use of Stein's composites as drawn pans is disclosed with sufficient specificity to anticipate the rejected claims. Applicant argues that the reduction ratios of the examples can be used to determine whether specific embodiments are directed towards automotive trim or towards the manufacture of pans. The examiner finds applicant's argument to be mere speculation of Stein's intentions and does not outweigh the general recitation by Stein that his composites are useful for cooking utensils. Regarding Stein's excerpt discussing the use of stainless steel on the cooking side of the vessel and aluminum on the heating side of the pan (e.g. see column 2, lines 37-41), the recitation of this advantage describes the two layer construction of the pan in Example 2. While Stein discloses the advantages of this particular steel/aluminum embodiment for pans, Stein clearly does not rule out his other disclosed material combinations for use in cooking utensils (as evidenced by the stainless steel/aluminum/stainless steel pan manufactured in Example 3).

11. Regarding the applicant's generic recitation of "cookware" in claims 1, 4 and 13-18, the examiner notes that no particular physical structure is imparted on the claims by this recitation

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since "cookware" can be any shape. The term "cookware" does not physically distinguish these claims from the applied art. A flat metal composite sheet is certainly capable of being used as cookware.

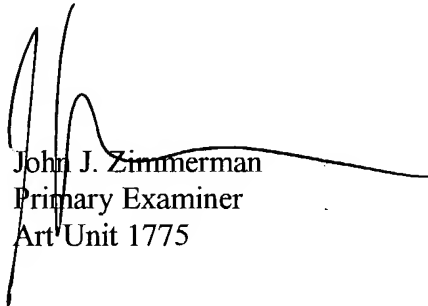
Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
September 3, 2004